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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,401	03/02/2005	Akihiro Fukasawa	1190-060 1PUS1	7072
2292 7590 05/18/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER KLIMOWICZ, WILLIAM JOSEPH	
			ART UNIT 2627	PAPER NUMBER
			NOTIFICATION DATE 05/18/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

**Application No.**

10/526,401

**Applicant(s)**

FUKASAWA, AKIHIRO

**Examiner**

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

*Lack of Unity of Invention*

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species A: Figure(s) 1-9(c)

Species B: Figure(s) 10-12

Species C: Figure(s) 13-15

Species D: Figure(s) 16-19

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the aforementioned Species each include special

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structural features, as evidenced by their respective drawings, which cannot be said to be found in the other respective drawings of the remaining Species; thus, *prima facie*, the Species are considered to contain special technical features which are patentably distinct at this time; until Applicant provides evidence or admits for the record that such enumerated Species (A-D) are not patentably distinct.

Moreover still, that is, each of the Specie groupings articulated by the associated Figure(s), *supra*, has been described by the Applicant's specification as being exclusive and distinct from the other Groupings.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

### ***Serious Burden***

Additionally, each of the various disclosed species details a mutually exclusive characteristic of a disk device as evidenced by the representation of each various species with a

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different figure or set of figures. A search for one of these mutually exclusive characteristics is not coextensive with a search for the other mutually exclusive characteristics and therefore searching for all mutually exclusive characteristics could not be done without *serious burden*.

Moreover still, the search for one distinctly claimed and mutually exclusive specie, is not required for the other(s).

The Examiner *additionally* maintains that each identified Species and/or Restriction invention Grouping, as articulated in the Restriction & Election of Species Requirement, *supra*, would impose other grave, *serious burdens* upon the Examiner. Moreover, in accordance with **37 CFR 1.104**, to the nature of each distinctly grouped Species and/or Grouping, the Examiner must make a thorough study thereof and a thorough investigation of the available prior art relating to the claimed subject matter of each distinctly identified Species and/or Grouping. The examination for each distinct Specie/Groping must be complete with respect both to compliance of the application with the applicable statutes and rules and to the patentability of the invention as claimed, in addition to matters of form, including **Title 35** to the **United States Code**, sections **101, 102, 103** and **112**, to each distinctly grouped invention.

Moreover, each separately grouped specie/invention must be thoroughly searched, including, but not limited to, various searching fields, inclusive of differing text search strategies and/or queries, determination of anticipation, if any, of uncovered prior art, potential application of the Graham factual inquiries to each distinct specie/invention to review for any indicia of possible obviousness, etc.

Moreover still, as has been held, if there is an express admission that the claimed inventions would have been obvious over each other within the meaning of **35 U.S.C. § 103**, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

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***There is nothing on record, at present, to show that the distinctly grouped species/inventions are obvious variants.***

Moreover, the Applicant has not established that each of the aforementioned Product, Process and/or Species are not separately patentable, nor has Applicant submitted evidence or identified such evidence now of record showing the Product, Process and/or Species to be obvious variants or clearly admit on the record that this is the case. If the Applicant were to include such a statement, ***the election/restriction requirement would be withdrawn***. In either instance, however, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under **35 U.S.C. § 103** of the other invention.

Thus, in addition to electing one of the Product or Process Groups, *supra*, the Applicant is required under **35 U.S.C. 121** to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Additionally, the Applicant being the inventor of the claimed subject matter, is asked to identify which claims are considered generic to the Applicant's claimed subject matter.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (**37 CFR 1.143**) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not ***distinctly*** and ***specifically*** point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

If the Applicant traverses the election/restriction requirement, the Examiner will judiciously assay the traversal to determine whether the Applicant has admitted, either implicitly or explicitly, that the restricted inventions and/or species bear no patentable distinctness between each Grouping, Specie and/or sub-grouping(s) and subspecie(s), as set forth, *supra*.

Should Applicant traverse on the ground that the inventions or Species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or Species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under **35 U.S.C.103(a)** of the other invention.

#### ***Rejoinder Considerations Pertaining to Product & Process Claims***

As it pertains to the restriction between the product and process claims, the following should be noted. Where Applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with **37 CFR 1.104**. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of **35 U.S.C. §§ 101, 102, 103 and 112**. Until all claims to the elected product are found allowable, an otherwise

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proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See **MPEP § 821.04(b)**. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of **35 U.S.C. 121** does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See **MPEP § 804.01**.

***Rejoinder Considerations Pertaining to Species Election***

As it pertains to the restriction between the distinctly identified Species, *supra*, the following should be noted.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional Species which depend from or otherwise require all the limitations of an allowable generic claim as provided by **37 CFR 1.141**. If claims are added after the election, Applicant must indicate which are readable upon the elected species. **MPEP § 809.02(a)**.

In the event of rejoinder, the requirement for restriction between the distinctly grouped Species will be reconsidered, and any rejoined claims will be fully examined for patentability in accordance with **37 CFR 1.104**. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of **35 U.S.C. §§ 101, 102, 103 and 112**. Withdrawn Species claims that do not depend from an allowed generic linking claim will not be rejoined. Further, note that the prohibition against double patenting rejections of **35 U.S.C. 121** does not



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apply where the restriction requirement is withdrawn by the Examiner before the patent issues.

See MPEP § 804.01.

***Joint Inventor(s), if Any***

If there is more than one inventor, the following should be noted: Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with **37 CFR 1.48(b)** if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under **37 CFR 1.48(b)** and by the fee required under **37 CFR 1.17(i)**.

***Conclusion***

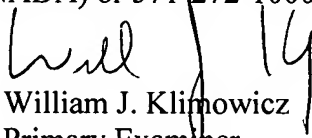
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **ONE (1) MONTH OR THIRTY (30) DAYS**, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of **37 CFR 1.136(a)**. In no event, however, may a reply be timely filed after **SIX (6) MONTHS** from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (**35 U.S.C. § 133**). Any reply received later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See **37 CFR 1.704(b)**.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Friday (7:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2627

WJK